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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,217	09/23/2003	Robert W. Esmond	4012.0373-02000	2163

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EXAMINER

KIM, VICKIE Y

ART UNIT PAPER NUMBER

1618

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/669,217

Applicant(s)

ESMOND ET AL.

Examiner

Vickie Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13, 17-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13, 17-19 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/394,712.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/10/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *RCE acknowledged*

1. A request for continued examination(RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/31/05 has been entered.

### *Status of application*

2. All the pending claims 13, 15, 17-19 and 21 were previously indicated as allowable subject matter. **Claims 13, 15, 17-19 and 21 are presented for examination.**

### *Information Disclosure Statement(IDS)*

3. RCE has been filed 5/31/05 with submission of supplemental IDS which includes several information sheets. However, the papers submitted with IDS are not considered as formal documents. Although these papers was reviewed, the examiner refused to initial and enter. Since formal documents(US patent application publication corresponding to these papers, the examiner includes these formal documents initialed and signed in PTO-892.

1) Office action mailed August 25, 2004, in Application No. 10/669281, filed September 23, 2003.

a. Acknowledgement is made of the papers submitted with IDS on 2/7/05(original submission date Applicant is informed that the review is done.b.

Inadvertent typographical error was found. 10/669281 is incorrectly typed 09/669281. The correction is made by examiner and corrected application number is used hereinafter.

c. The corresponding US patent application publication (US2004/0058873) is reviewed and enclosed in PTO-892.

Note: Although current claims prosecuting with co-pending application 10/669281 has been amended to avoid Double patenting rejection with claims now allowed in the instant application 10/669217, the claims 13-20 found in publication US2004/0058873 is conflicting with the instant claims(10/669217) now under the condition for allowance.

Double patenting rejection is necessary to avoid any further conflict. Filing terminal disclaimer would avoid Double patenting rejection.

2) Copy of pending claims for US patent application No. 10/936709 filed September 9, 2004.

a. Acknowledgement is made of the papers submitted with IDS on 2/7/05(original submission date). Applicant is informed that the review is done.

b. The corresponding US patent application publication (US2005/0043242) is reviewed and enclosed in PTO-892.

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c. Original claims are amended before publication, the currently amended claims in both publication and in prosecution would not be conflicting with the instant claims(10/669217) under the condition for allowance.

3) Supplementary European Search Report for Application No. EP 98919105, dated May 24, 2004.

a. Acknowledgement is made of the papers submitted with IDS on 2/7/05(original submission date Applicant is informed that the review is done.

4) A copy of an interference request for US application 09/394712 with US Patent No.6191154, dated March 29, 2001.

a. Acknowledgement is made of the papers submitted with IDS on 2/7/05(original submission date). Applicant is informed that the review is done.

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 13, 17-19 and 21 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-20 of copending Application publication No. 2004/0058873. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the claims found in instant application and said patent publication are commonly share same subject matter that is directed to a method for the treatment of Alzheimer's disease using an agent(i.e. chromium, insulin-like growth factor and a thiazolidinedione) and restricting the metabolizable carbohydrates in the diet.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### **Conclusion**

1. No claim is allowed.
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is 571-272-0579. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Low be reached on 571-272-0953. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**VICKIE KIM**  
**PRIMARY EXAMINER**

Vickie Kim  
August 8, 2005  
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